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Colleen Coyne

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jack W. Szostak et al.	Art Unit:	1634
Serial No.:	09/876,235	Examiner:	Forman, B.J.
Filed:	June 6, 2001	Customer No.:	31020
Title:	SELECTION OF PROTEINS USING RNA-PROTEIN FUSIONS		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO OFFICE COMMUNICATION

Applicants submit the following remarks in response to the Office Communication dated July 24, 2003, in connection with the above-referenced application. Applicants also submit herewith a petition for a five-month extension of time to respond to the Office Action and the requisite extension fees. Applicants also note with appreciation the helpful suggestions from Examiners Forman, Benzion and Woodward.

Remarks/Arguments begin on page 2 of this paper.

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REMARKS

Applicants address the issues raised by the Examiner below:

A. Applicants Have Complied with 37 C.F.R. 1.607 for the Request for Interference with the '943 Patent.

Applicants acknowledge with appreciation the Examiner's conclusion that Applicants have met the burden under 37 C.F.R. 1.607(c).

B. Showing Under 37 C.F.R. 1.608(b) is Inapplicable in this Case

The issue at hand in the present application concerns the request for an Interference between pending claims of the instant application and claims issued in US Patent 6,361,943 (the '943 Patent). The '943 Patent issued March 26, 2002, was filed June 2, 1999, and claims priority to PCT application PCT/JP97/03766 filed October 17, 1997 and Japanese application 8-274855 filed October 17, 1996.

The outstanding Office Action states "because the filing date of the foreign application to which the '943 claims priority (17 October 1996) is more than three months prior to the filing date of the provisional application to which Applicants claim priority 37 CFR 1.608(b) is in effect. Therefore, Applicants must make a showing under 37 C.F.R. 1.608(b) to provoke an interference (see MPEP2308)."

Applicants respectfully submit that no showing under 37 CFR 1.608(b) should be required. Applicants agree that the MPEP is instructive on this point. However, contrary to the position of the outstanding office action, MPEP 2308.01 states:

“When an applicant attempts to provoke an interference with a patent, the examiner must determine the effective filing dates of the application and of the patent; only the patent's effective United States filing date will be considered. Any claim of foreign priority by the patentee under 35 U.S.C. 119(a) will *not be taken into account* when determining whether or not an interference should be declared, in order to be consistent with the holding in In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966)” [emphasis added] MPEP 2308.1, Eighth Edition, August 2001 as revised February 2003 on www.uspto.gov.

The present application is a continuation of United States Application Serial No. 09/247,190, filed February 9, 1999, now US Pat. No. 6,261,804, which is a continuation-in-part of Application No. 09/007,005, filed January 14, 1998, now US Pat. No. 6,258,558, which claims benefit of the filing dates of Provisional Application No. 60/064,491, filed November 6, 1997 and Provisional Application No. 60/035,963, filed January 21, 1997. The Examiner has accepted the Applicants' claim to the earliest priority date. Thus, the earliest effective U.S. filing date for the present application is January 21, 1997. In contrast, the '943 Patent is a national stage filing under 35 U.S.C. § 371 and is based on a PCT international application (PCT/JP97/03766). This patent has a § 102(e) date and a § 371 date of June 2, 1999, as printed on the face of the patent. The corresponding PCT application was filed on October 17, 1997. Based on MPEP 2308.01 as quoted above, the foreign priority date of the Japanese application of October 17, 1996 is not taken into account in determining *whether* an

interference should be declared. Thus, the earliest possible effective U.S. filing date of the '943 Patent is October 17, 1997.

Accordingly, Applicants respectfully submit that the present application's effective U.S. filing date (January 21, 1997) is more than three months prior to that of the '943 Patent (October 17, 1997 or June 2, 1999), and that 37 C.F.R. 1.608(b) should not be applied in this case. Should the requirement of a showing under 37 C.F.R. 1.608(b) continue to be applied, Applicants respectfully request clarification in view of MPEP 2308.01 and In re Hilmer.

Applicants wish to thank Examiners BJ Forman, Gary Benzion and Michael Woodward for helpful suggestions in telephonic conversations of January 23, 2004 and January 26, 2004. In those conversations, it was offered that the PTO would consider a response traversing the requirement of a showing under 37 C.F.R. 1.608(b) on the basis set forth above, along with a request for clarification should the 1.608(b) continue to be an issue raised by the Examiner, as a *bona fide* attempt at a complete reply to the outstanding office action.

Applicants also note that they have undertaken the preparation of submissions of evidence for meeting the requirements of 37 C.F.R. 1.608(b). Should the Examiner clarify an appropriate basis for why a showing under 37 C.F.R. 1.608(b) is required in the present application, Applicants will promptly submit evidence and affidavits which demonstrate that Applicants are *prima facie* entitled to a judgment relative to the '943 Patent.

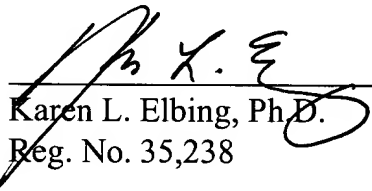
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that an interference should be declared, and Applicants should be granted senior party status. Applicants also submit herewith a petition for a five-month extension of time to respond to the Office Action and the requisite extension fees.

If there are any other charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 26 Janay 2004


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